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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,207	12/07/1999	JEREMY VANDER WOUDE	MPATENT.160A	7416
20995	7590	01/09/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			KUMAR, PANKAJ	
		ART UNIT	PAPER NUMBER	
		2631		
DATE MAILED: 01/09/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/457,207	WOUDE, JEREMY VANDER	
	Examiner Pankaj Kumar	Art Unit 2631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10/27/2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-5,8 and 11-23 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-5,8,11-16,19,22 and 23 is/are rejected.
- 7) Claim(s) 17,18,20 and 21 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant had requested me to call him after reviewing the effect of his amendments. I called John King at 949-760-0404 on 12/4/2003. He was not available so I left a message with the person who answered the phone. He called back on 12/9/2003.
2. When John King called and I informed him that the amendments overcome the current 103 rejection. However, the current reference can still be used in another 103 rejection.
3. Applicant's arguments with respect to claims 1, 3, 4, 5, 8, 11 have been considered but are moot in view of the new ground(s) of rejection.

Response to Amendment

Claim Objections

4. Claims 1 and its dependent claims are objected to because of the following informalities: Claim 1 has “a modem” in the preamble and then another “a modem” in the fifth line. Then claim 1 has “the modem” in lines 8, 9, 14 and 15. It is not clear which modem “the modem” is referring to.
5. Claims 5 and its dependent claims are objected to because of the following informalities: Claim 5 has “a modem” in the preamble and then another “a modem” in the third line. Then claim 5 has “the modem” in lines 6 and 10. It is not clear which modem “the modem” is referring to.
6. Claims 8, 11 and their dependent claims have similar issues.
7. Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3, 4, 5, 8, 11, 12-16, 19, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carnahan et al. 6,560,557.

10. As per claim 1, Carnahan teaches a device for testing the operation of a modem in a computer, the device comprising: a case (inherent to be within a case to reduce the effect of temperature, humidity, liquid spilling and other environmental effects); a first communication port (Carnahan fig. 1: 23) attached to the case (Carnahan fig. 1: 23 is attached to case 11) and configured to be directly coupled to a modem in a computer (Carnahan fig. 1: 22, 23, 24) thereby forming a primary communication link receive signals from a modem in a computer; a second communication port (Carnahan fig. 1: 5) coupled to a signal reporting circuit (Carnahan fig. 1: 2B) and configured to be coupled with the computer (Carnahan fig. 1: 5 configured to be coupled to computer 24 via other components) and to bypass the modem (Carnahan fig. 1: connection 7 bypasses modem 22) thereby forming a secondary communication link that bypasses the modem (Carnahan fig. 1: connection 7 bypasses modem 22) and wherein the signal reporting circuit is located within the case (Carnahan fig. 1: 2B is located within case 11) and coupled to the first communication port (Carnahan fig. 1: 2B is coupled to 23 via connection 7) and the second communication port (Carnahan fig. 1: 2B is coupled to 5), the signal reporting circuit including a

microprocessor (Carnahan fig. 1: inherent inside 2B) configured to send a signal to the computer via a secondary communication link (Carnahan fig. 1: 2B sends a signal via 7 and 23 to 24) to evaluate test the transmit capability of the modem in the computer over the primary communication link (It is inherent to evaluate the transmit capability based on whether a receiver receives the transmitted signal.)

11. Carnahan does not teach initiating the transmission of test data from the modem in the computer via the primary communication link.
12. It is common knowledge to have a secondary communication link initiate transmission of test data from the primary communication link.
13. It would have been obvious to one skilled in the art at the time of the invention to modify Carnahan to have a secondary communication link to initiate transmission of test data from the primary communication link.
14. One would be motivated to do so since it would be advantages to have backup communication routes if a primary communication route fails or is clogged with traffic.
15. As per claim 3, Carnahan teaches the device of claim 1 wherein the signal reporting circuit comprises a microprocessor and an analog to digital converter coupled to the microprocessor and the first communication port (Carnahan fig. 1: inherent since 2A shows an analog signal and the data has to go to computer, modem, port, etc. which are all digital)

16. As per claim 4, Carnahan teaches the device of claim 1 wherein the signal reporting circuit comprises a microprocessor and a modem coupled to the microprocessor and the first communication port (Carnahan fig. 1: 2B, 5, 22, 23).

17. As per claim 5, Carnahan teaches a method of testing the operation of a modem in a computer using a portable modem testing device, the method comprising: coupling the modem in the computer (Carnahan fig. 1: 22, 23, 24) to the portable (not in Carnahan but would be obvious – see below) modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4); coupling the computer (Carnahan fig. 1: 24) to the portable modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4) via an alternate communication link and to bypass the modem (Carnahan fig. 1: 24 to 23 to 3A via 6 to 2A to 4 bypasses modems 5, 22); sending a signal from the portable modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4) to the computer (Carnahan fig. 1: 24) via the alternate communication link (Carnahan fig. 1: 24 to 23 to 3A via 6 to 2A to 4 bypasses modems 5, 22) to initiate testing the operation of the modem in the computer; initiating transmission of test data from the modem; receiving the transmission (Carnahan fig. 1: 8A) from the modem (Carnahan fig. 1: 22) at the portable modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4); and verifying the transmission (inherent to verify transmission when testing a modem).

18. Carnahan teaches a modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4) but does not teach a portable modem testing device.

19. It is common knowledge to make things portable.

20. It would have been obvious to one skilled in the art at the time of the invention to modify make the elements portable.

21. One would be motivated to do so since it has been held that to make something portable requires routine skill in the art.

22. Carnahan does not teach to initiate testing the operation of the modem in the computer and to initiate transmission of test data from the modem. It is common knowledge to send a signal from the portable modem testing device to the computer via the alternate communication link to initiate testing the operation of the modem in the computer and initiate transmission of test data from the modem.

23. It would have been obvious to one skilled in the art at the time of the invention to modify Carnahan to have a secondary communication link to initiate transmission of test data from the primary communication link.

24. One would be motivated to do so since it would be advantages to have backup communication routes if a primary communication route fails or is clogged with traffic.

25. It is also common knowledge to test modems.

26. It would also have been obvious to one skilled in the art at the time of the invention to modify Carnahan to test the modem.

27. One would be motivated to do so in order to know that one has a modem that functions.

28. As per claim 8, Carnahan teaches a method of testing the operation of a modem in a computer using a ~~portable~~ modem testing device, the method comprising: coupling the modem in the computer (Carnahan fig. 1: 22, 23, 24) to the ~~portable~~ modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4); coupling the computer (Carnahan fig. 1: 24) to the modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4) via an alternate communication link that bypasses the modem

(Carnahan fig. 1: connection 7 bypasses modem 22); sending a signal to a computer via the alternate communication link to initialize the modem in the computer (Carnahan fig. 1: 2B sends a signal via 7 and 23 to 24); initiating transmitting of test data from the portable modem testing device (Carnahan fig. 1: 2B sends a signal – during testing, this would be a test signal); receiving the transmission from the portable modem testing device at the modem in the computer (Carnahan fig. 1: 2B sends a signal to modem in the computer 22, 23, 24 via 5 and 8B); and verifying the transmission (inherent to verify transmission when testing a modem); transmitting test data from the modem (Carnahan fig. 1: 22, 23, 24 send signals - during testing, these would be test signals) to the modem testing device (Carnahan fig. 1: 2B); verifying the test data (inherent to verify test data when testing).

29. As per claim 11, Carnahan teaches a method of testing the operation of a modem in a computer using a portable modem testing device, the method comprising: coupling the modem in the computer to the portable modem testing device; coupling the computer to the modem testing device via an alternate communication link; initiating transmission of test data from the modem by sending a signal from the modem testing device over the alternate communication link; receiving the transmission from the modem at the portable modem testing device; verifying the transmission; initiating transmission of test data from the portable modem testing device; receiving the transmission from the portable modem testing device at the modem; and verifying the transmission (discussed above with Carnahan with claims 1, 5 and 8).

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30. As per claim 12, Carnahan does not teach RJ11 jack. It is common knowledge to have a RJ11 jack. It would have been obvious to one skilled in the art at the time of the invention to modify Carnahan to teach a RJ11 jack since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

31. As per claims 13-16, 19, 22 and 23, Carnahan teaches memory, storing test data and software in the memory, microprocessor with the computer 24 as well as 4, 2A and 2B since computers function by running software programs from memory and storing data in memory and they have microprocessors. It is inherent to store test data in memory, if not permanently, at least for the purpose of determining whether a communication channel exists. When testing, the microprocessor would be involved in determining the validity of the test.

Allowable Subject Matter

32. Claims 17, 18, 20, 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: The art of record does not suggest the respective claim combinations together and nor would the respective claim combinations be obvious with the following underlined portions:

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33. As per claim 17, verifying the transmission further comprises: receiving a second transmission of the test data via the alternate communication link; and comparing the transmission of the test data with the second transmission of the test data.
34. As per claim 18, verifying the test data comprises: comparing the test data received from the modem with the test data transmitted by the modem testing device.
35. As per claim 20, verifying the transmission from the modem testing device comprises comparing the transmitted test data with a known data set.
36. Claim 21 depends on claim 20.

Conclusion

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pankaj Kumar whose telephone number is (703) 305-0194. The examiner can normally be reached on Mon, Tues, Wed and Thurs after 8AM to after 6:30PM.
38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad H. Ghayour can be reached on (703) 306-3034. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.
39. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



A handwritten signature in black ink, appearing to read "Pankaj Kumar". Below the signature, the initials "PK" are handwritten.